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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/715,676	11/17/2000	Stephen Neushul	60414P003	7832

7590 04/22/2005  
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EXAMINER

GIBBS, HEATHER D

ART UNIT PAPER NUMBER

2622

DATE MAILED: 04/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/715,676	NEUSHUL, STEPHEN	
	<b>Examiner</b>	<b>Art Unit</b>	
	Heather D Gibbs	2622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 12 October 2004.
- 2a) ☒ This action is **FINAL**.      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☒ Claim(s) 9-15 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 November 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

*Response to Arguments*

1. Applicant's arguments filed 10/12/04 have been fully considered but they are not persuasive. Regarding claim 1, applicant argues, "Sasaki's moveable suction means 24 is not mounted to a side of the media receptacle." Examiner has reviewed these arguments and respectfully disagrees. The moveable suction means 24 is indeed mounted to a side of the media receptacle. Please see Fig 4B or a more concise picture. Examiner is even willing to argue that the moveable means is mounted *via* the drive mechanism, but it is mounted to the frame of the apparatus. Secondly, Applicant argues, "the selector switch identified by the Examiner at Sasaki Column 5, lines 60-68, is not analogous to a switch coupled to the clip to cause the suction device to disengage the first media object." Upon further consideration, the Examiner finds this argument moot. The switch in Sasaki removes unexposed film to prevent the removal of any superposed film. The film (media object is disengaged prior to removal of the film (by a switch). Please review previously cited, column 5 lines 60-68.

Regarding claim 8, Applicant argues "Claim 8 requires a clip coupled to a receptacle to engage and hold a media object from the receptacle during a digitization process." Upon further review, the examiner finds this limitation to be additionally taught in Col 2 Lines 41-56. Secondly, applicant argues "Claim 8 requires a suction assembly coupled to the receptacle to move the media object from the receptacle to engagement with the clip." Again, this limitation can be clearly shown/taught in Col 2 Lines 51-56.

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Examiner reminds the applicant that claims 9-15 are objected to as being allowable if rewritten in independent form.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1,8 are rejected under 35 U.S.C. 102(b) as being anticipated by Sasaki et al (US 4,920,553).

Regarding claim 1, which is representative of claim 8, Sasaki teaches of an apparatus comprising: a media receptacle 21,22 to hold a plurality of media objects (Col 2 Lines 29-40); a clip 26 to engage and hold a media object; a suction device 24 mounted to a side of the media receptacle to engage a first media object within the receptacle and move it to be engaged by the clip (Col 2 Lines 41-56); and a switch coupled to the clip to cause the suction device to disengage the first media object (Col 5 Lines 60-68).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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5. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sasaki et al (US 4,920,553) in view of Blum (US 4,280,691).

Sasaki discloses the apparatus as discussed above in claims 1 and 8.

Sasaki does not disclose expressly a suction chamber having a perforated plate defining at least a portion of one side thereof, the perforated plate also defining a portion of an interior surface of the receptacle; and a suction pump coupled to the suction chamber to evacuate the suction chamber thereby exposing the interior of the receptacle to suction through the perforated plate.

Blum discloses a cover plate 22 that comprises a suction hole 21 for the ventilator<sup>4</sup>. The base plate of the suction chamber 3 is designed as a perforated plate 2, so that the perforated plate 2 lifts the uppermost sheets from the stack 16 (Col 1 Lines 67-68; Col 2 Lines 1-6; Col 3 Lines 50-56; Col 4 Lines 23-26)

Sasaki & Blum are combinable because they are from the same scope of nature.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to utilize Blum's invention in that of Sasaki.

The suggestion/motivation for doing so would have been as both systems utilize image-processing means and Blum teaches wherein his device is used for automatic feeding.

Therefore, it would have been obvious to combine Sasaki with Blum to obtain the invention as specified in claim 2.

6. Claims 3,5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sasaki et al (US 4,920,553) in view of Ford et al (US 6,077,568).

Sasaki discloses the apparatus as discussed above in claims 1 and 8.

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Sasaki does not disclose expressly a light box coupled to the receptacle; a housing wherein the receptacle is coupled to the housing to move between a first position and a second position and wherein in the first position the light box is aligned with the clip and in the second position the receptacle is aligned with the clip.

Ford discloses a light box 23 that is assembled on a support arm 24 which may be pivoted from a position in which the light box 23 has been moved away from the receptacle 12, to a position in which the light box 23 is in alignment with the receptacle 12 (Fig 1; Col 3 Lines 21-25; Col 5 Lines 13-30; Col 6 Lines 26-32).

Sasaki & Ford are combinable because they share cumulative features making them additive in nature.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine Sasaki and Ford.

The suggestion/motivation for doing so would have been as Ford teaches of positioning a light box for maintenance purposes and to supply cooling compressed air.

Therefore, it would have been obvious to combine Sasaki with Ford to obtain the invention as specified in claim 3.

Considering claim 5, Ford teaches wherein in the first position the receptacle is recessed with the housing (Col 5 Lines 21-30).

7. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sasaki et al (US 4,920,553) in view of Ford et al (US 6,077,568) and further in view of Gardner et al (US 3,868,699).

Sasaki discloses the apparatus as discussed above.

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Sasaki does not disclose expressly wherein a light box comprises a translucent plate; and a plurality of thin cold cathode lamps.

Gardner discloses a light box 126 that includes a transparent plate 121 and a plurality of lamps 124 (Col 5 Lines 16-19).

Sasaki, Ford & Gardner are combinable because they are from the same scope of nature of image processing.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to utilize Gardner's light box in the apparatus of Sasaki and Ford.

The suggestion/motivation for doing so would have been as all three systems share cumulative features making them additive in nature.

Therefore, it would have been obvious to combine Sasaki and Ford with Gardner to obtain the invention as specified in claim 4.

8. Claims 6-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sasaki et al (US 4,920,552) in view of Daisuke et al (JP 09-240858).

Sasaki discloses the apparatus as discussed above in claim 1.

Sasaki does not disclose expressly a housing defining a scanning window; a digitizer mounted within the housing, wherein the clip transports the media object past the scanning window during operation.

Daisuke et al discloses a document holder that includes a digitizer 30 and two scanning windows 19 and 20 within a housing (ABSTRACT).

Sasaki & Daisuke are combinable because they are from the same scope of nature.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine Sasaki and Daisuke.

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The suggestion/motivation for doing so would have been as Daisuke teaches wherein his system allows a document holder to be inserted in to an image digitizer, as similar to applicants claimed invention.

With regard to claim 7, Sasaki teaches wherein the clip further comprises a release lever to be engaged by the housing after the clip has transported the media object past the scanning window, the release lever causing the clip to release the media object when engaged (Col 5 Lines 60-68).

Therefore, it would have been obvious to combine Sasaki with Daisuke to obtain the invention as specified in claim 6.

***Allowable Subject Matter***

9. Claims 9-15 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

10. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant



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to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Heather D Gibbs whose telephone number is 571-272-7404. The examiner can normally be reached on M-Thu 8AM-6PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on 571-272-7402. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

hdg

  
Heather D Gibbs  
Examiner  
Art Unit 2622

